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Paper No. 32

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In re Application of :
Dane K. Fisher et al. :
Application No. 09/394,745 : DECISION ON PETITION
Filed: September 15, 1999 : UNDER 37 CFR 1.181(a)(3)
For: Nucleic Acid Molecules and Other :
Molecules Associated with Plants

This is a decision on the petition filed on January 12, 2004, requesting reconsideration of a petition under 37 CFR 1.181(a)(3) to invoke the supervisory authority of the Director of the United States Patent and Trademark Office (Director) to review the May 12, 2003 decision of the Director of Technology Center 1600 (Technology Center Director).[1]

The petition to invoke the supervisory authority of the Director to review the May 12, 2003 decision of the Technology Center Director remains **dismissed** as premature.

Petitioners argue (inter alia) that: (1) the examination in the above-identified application is based upon only a single embodiment within the claims; and (2) the Office has no authority to establish a policy of piecemeal examination.

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[1] The Technology Center Director's decision of May 12, 2003 denied the petition under 37 CFR 1.144 of April 14, 2003, which petition requested withdrawal of the restriction requirement set forth by the examiner in the above-identified application. A petition under 37 CFR 1.181(a)(3) requesting higher level review of the Technology Center Director's decision of May 12, 2003 was dismissed as premature by the Deputy Commissioner for Patent Examination Policy in a decision dated November 12, 2003.

Petitioners' arguments have been carefully considered; however, the salient facts remain that: (1) claims 8 through 11 are the only claims pending in the above-identified application; (2) the final Office action of November 11, 2002 includes a rejection of claims 8 through 10 under 35 U.S.C. § 112, ¶ 2, a rejection of claims 8 through 11 under 35 U.S.C. § 101, and a rejection of claims 8 through 11 under 35 U.S.C. § 112, ¶ 1; (3) the rejections of claims 8 through 11 are the subject of an appeal to the Board of Patent Appeals and Interferences (BPAI); and (4) no claim has been withdrawn from consideration as a result of the restriction requirement at issue in the above-identified application.

Since no claim has been withdrawn from consideration in the above-identified application as a result of the restriction requirement that is the subject of the instant petition, the examiner is not refusing to examine any claim in the above-identified application as a result of the restriction requirement and petitioner's complaints concerning this restriction requirement are premature. To the extent that petitioners are arguing that the rejections of claims 8 through 11 under 35 U.S.C. § 101 or 35 U.S.C. § 112, ¶ 1, are improper, the propriety of the rejections of claims 8 through 11 under 35 U.S.C. § 101 or 35 U.S.C. § 112, ¶ 1, are reviewable on appeal by the BPAI, and the Director will not usurp the functions or impinge upon the jurisdiction of the BPAI. In re Oku, 25 USPQ2d 1155, 1157; In re Dickinson, 299 USPQ 954, 958, 133 USPQ 39, 43 (CCPA 1962).

While Office personnel are to state all non-cumulative reasons and bases for rejecting claims in the first Office action under the Office's "compact prosecution" policy, this policy is a matter of internal Office management and does not vest applicants with the right to have their applications examined in any particular manner. Cf. Ex parte Pearce, 1960 Dec. Comm'r Pat. 19, 22-23, 128 USPQ 122, 124 (Bd. Pat. App. 1959) (appellant's request to strike an untimely examiner's answer denied as the time period specified in the MPEP for preparing an examiner's answer is a "desideratum for administrative purposes"). The Office's reviewing court has indicated that it is permissible and even appropriate to defer imposition of any applicable prior art based rejection until the non-prior art based rejections have been resolved. See In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962). In the above-identified application, an affirmance of the rejection of claims 8 through 11 under 35 U.S.C. § 101 or under 35 U.S.C. § 112, ¶ 1, would moot any complaint concerning how these claims have been treated relative to the prior art. In any event, that deferring the consideration of a rejection may result in the need to reopen of prosecution subsequent to a decision on appeal is not a basis for petition or complaint by an applicant. See, e.g., In re Ruschig, 379 F.2d 990, 993, 154 USPQ 118, 121 (CCPA 1967) (subsequent to a court decision reversing a rejection, the Office is free to reopen prosecution and reconsider previously withdrawn rejections that are not inconsistent with the court's decision).

Therefore, the petition to request further review of the restriction requirement at issue is and remains premature unless and until at least one claim is withdrawn from consideration as a result of the restriction requirement.

It is noted that petitioners have twice petitioned for review of the Technology Center Director's decision of May 12, 2003 and of the restriction requirement set forth by the examiner in the above-identified application, and have now been twice advised that such petitions are premature at least until the BPAI renders a decision on the appeal in the above-identified application. Petitioners' request for administrative review of the Technology Center Director's decision of May 12, 2003 resulted in the need for the BPAI to remand the above-identified application (see BPAI remand dated July 24, 2003).. Petitioners are advised that any further requests for administrative review of the Technology Center Director's decision of May 12, 2003, or other similar action, which causes a delay in the BPAI's rendering of a decision on the appeal in the above-identified application may be considered a failure to act with due diligence under 37 CFR 1.701(d)(2).

Telephone inquires regarding this decision may be directed to Petitions Examiner Brian Hearn at (703) 305-1820.

Stephen G. Kunin
Deputy Commissioner
for Patent Examination Policy

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